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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,229	11/02/2001	Anita W-Y. Chan	AM100305	9006
25291	7590	02/25/2004	EXAMINER	
WYETH PATENT LAW GROUP FIVE GIRALDA FARMS MADISON, NJ 07940			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/016,229	CHAN, ANITA W-Y.	
	Examiner	Art Unit	
	Brenda L. Coleman	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 15-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/30/02, 11/20/03, 8-11/05/03</u>   | 6) <input type="checkbox"/> Other: ____.                                    |

### **DETAILED ACTION**

Claims 1-27 are pending in the application.

#### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in Paper dated November 20, 2003 is acknowledged. The traversal is on the ground(s) that the intermediate compounds of Claims 21, 23 and 25 are required in the process of Claim 1 and thus a search of the process of Claim 1 will also involve a search of the compounds of Claims 21, 23 and 25. The applicants additionally stated that the intermediate compounds of Claims 15, 17 and 19 are required in the process of Claim 27 and a search of the process of Claim 27 will involve a search of the intermediate compounds of Claims 15, 17 and 19 and thus it would not be a serious burden for the Examiner to search the intermediate compound claims of Group II while searching for the process claims of Group I. This is not found persuasive because the process of preparing the diazabenzocd]cyclopenta[a]azulene compounds of Claim 1 is classified separately from the intermediates of Claims 15-24 which are structurally dissimilar compounds, i.e. cyclopenta[b]indole and are classified in various subclasses under class 548. If a reference for one would not be a reference for the other, then restriction is considered proper.

Thus, separate searches in the literature would be required. However, should applicant traverse on the ground that the intermediates are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior

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art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The class/subclass search on the elected invention, i.e. the process of preparing the diazabenz[cd]cyclopenta[a]azulene compounds would be as follows: class 540, subclasses 555 and 556 which involved 221 US patents. The various classes and subclasses mentioned above represent only the degree of burden within the U.S. Patent Classification System, this does not include the search required in the prior art of journal articles and foreign patents.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 15-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper filed November 20, 2003.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-14 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

a) Claims 1, 2, 4, 6 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the capital letter "D" in the nomenclature of the

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formula in claims 1, 2, 4 and 6. Capital letters have a certain purpose in parts of the nomenclature as in 8H, but Diazabenzocyclopentaazulene is also capitalized.

608.01(m) Form of Claims [R - 3]

The claim or claims must commence on a separate sheet and should appear after the detailed description of the invention. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim", "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the clerk. **Each claim begins with a capital letter** and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, >36 USPQ2d 1211 (D.D.C. 1995). \*\* >Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

- b) Claim 2 is vague and indefinite in that it is not known what is meant by "Claim 1, above".
- c) Claims 3, 5, 6, 7, 8, 9, 11, 12, 13 and 14 are vague and indefinite in that it is not known what is meant by "A process" at the beginning of each claim.
- d) Claims 9, 12 and 13 recite the limitation "R" in the claim as being as defined in Claim 1. There is insufficient antecedent basis for this limitation in the claim.
- e) Claims 11 and 14 recite the limitation "R" is hydrogen. There is insufficient antecedent basis for this limitation in the claim.

***Claim Objections***

- 4. Claims 7 and 8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be in the alternative. See MPEP § 608.01(n).

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Any inquiry concerning this communication, or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting -SPE of 1624 at 571-272-0661.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda Coleman  
Primary Examiner Art Unit 1624  
February 22, 2004